

## **B. The Cited Reference- United States Patent Number 5,075,370 ("Kubitza")**

Kubitza teaches and discloses an aqueous coating composition. As defined in claim 1, the invention of Kubitza is a **two component coating composition** wherein the binder components comprise:

(a) a polyol component comprising an aqueous solution and/or dispersion of at least one polyacrylate containing hydroxyl groups and prepared from olefinically unsaturated compounds, said acrylate containing chemically incorporated groups comprising a member selected from the group consisting of carboxylate groups, sulfonate groups, and mixtures of carboxylate and sulfonate groups in a quantity which is sufficient to make said polyacrylate soluble and/or dispersible in water; and

(b) a polyisocyanate component containing free isocyanate groups and having a viscosity at 23 C of about 50 to 10,000 mPA.s and comprising at least one organic polyisocyanate,

wherein components (a) and (b) are present in quantities corresponding to an NCO:OH equivalent ratio of 0.5:1 to 5:1 and component (b) is present in emulsified form in component (a).

## **C. Traversal of the Claim Rejection**

In order for a rejection to be proper under 35 U.S.C. §102(b), a single source must contain all of the elements of the claim. See Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986). Further, a proper 35 U.S.C. §102(b) rejection requires that the reference must sufficiently describe the claimed invention to have placed the public in possession of it. See Minnesota Mining & Mfg. Co. vs. Johnson & Johnson Orthopaedics Inc., 976 F.2d 1559, 1572 U.S.P.Q.2d 1321, 1332 (Fed. Cir. 1992)

In this case, the present invention is a paint pack; not a coating composition. The paint pack of the present invention comprises i) a solution in an organic solvent of polymer having functional groups and hydrophilic groups; and ii) a waterborne pigment dispersion comprising pigment dispersed in water in the presence of a pigment dispersant, the aqueous pigment dispersion itself being in dispersion in said solution of organic solution.

The invention of Kubitza is a coating composition. Kubitza teaches and discloses a two component coating composition wherein the binder components comprise:

(a) a polyol component comprising an aqueous solution and/or dispersion of at least one polyacrylate containing hydroxyl groups and prepared from olefinically unsaturated compounds, said acrylate containing chemically incorporated groups comprising a member

selected from the group consisting of carboxylate groups, sulfonate groups, and mixtures of carboxylate and sulfonate groups in a quantity which is sufficient to make said polyacrylate soluble and/or dispersible in water; and

(b) a polyisocyanate component containing free isocyanate groups and having a viscosity at 23 C of about 50 to 10,000 mPA.s and comprising at least one organic polyisocyanate,

wherein components (a) and (b) are present in quantities corresponding to an NCO:OH equivalent ratio of 0.5:1 to 5:1 and component (b) is present in emulsified form in component (a).

In contrast to the present invention, Kubitza is a coating composition; not a paint pack. Further, Kubitza does not teach or disclose a paint pack having a **waterborne pigment dispersion comprising pigment dispersed in water in the presence of a pigment dispersant, the aqueous pigment dispersion itself being in dispersion in said solution of organic solvent (which contains the polymer).**

Because every element of the present invention is not taught or disclosed by the Kubitza reference, the rejection of claims 1-6, 8-10, and 13-15 under 35 U.S.C. §102(b) over Kubitza are improper and should be withdrawn. Clearly, Kubitza does not place the present invention in the possession of the public.

## **II. Rejection of Claims under 35 U.S.C. § 103(a) over Kubitza in view of United States Patent Number 5,820,925 ("Fenn")**

In the Office Action, claims 11-12, 16-18, 20-21, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubitza in view of Fenn.

### **A. Cited Reference- United States Patent Number 5,820,925 ("Fenn")**

The Fenn reference discloses and teaches a coating process. As described in claim 1, the invention of Fenn is a process for refinishing multiple motor vehicles with different color refinish paint, where each vehicle is painted with a pigmented refinish paint of a predetermined color, the refinish paint having reduced variability catalyzed pot life and cure time at a given catalyst level irrespective of the combination of pigments in the refinish paint, the process comprising:

a. selecting and mixing two or more pigmented base paints from a series of master color base paints to obtain a color paint pack, each pigmented base paint having a hydroxyl functional polymer selected from the group consisting of an acrylic addition polymer, a polyester polymer, and mixtures thereof, the hydroxyl polymer having a number average

molecular weight between about 600 and 10,000, and a hydroxyl value between about 5 and 500;

b. adding a hardener and a catalyst mixture to the color paint pack to obtain a thermosetting refinish paint of a predetermined color, the hardener being a polyisocyanate crosslinker to react and crosslink with said hydroxyl functional polymer in each base paint the catalyst mixture being a tin catalyst and a polyfunctional thiol having at least three thiol groups, where the ratio of the number of moles of thiol groups from the polyfunctional thiol to number of moles of tin from the tin catalyst is 1:1 to 500:1, to form a catalyzed refinish paint having reduced pot-life relative to thiol catalysts having less than three thiol groups, irrespective of the pigments contained in the color paint pack:

c. applying a layer of the refinish paint to the surface of the motor vehicle;  
and

d. causing the applied layer of refinish paint to dry and cure within a predetermined time.

#### **B. Traversal of the Rejection**

In order for there to be a proper rejection under 35 U.S.C. § 103(a), a combination of references must teach or suggest all of the limitations in the claims. See In re Wilson, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

In this case, the present invention is a process for making a paint pack. The process involves i) forming a solution of the polymer in an organic solvent; and ii) dispersing a waterborne pigment dispersion in the presence of a pigment dispersant in the polymer solution.

The Examiner stated in the Office Action that it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the coating taught by Kubitza into a paint pack to prevent premature hardening of the coating in view of the teachings of Fenn to store these compositions in a paint pack.

The problem with the Examiner's assertion is that even if one assumes Fenn teaches forming a "paint pack" from the coating composition of Kubitza, the combination of Kubitza and Fenn does not encompass a process for producing the paint pack of the present invention. As stated above, the paint pack formed from the process of the present invention comprises i) a solution in an organic solvent of polymer having functional groups and hydrophilic groups; and ii) a waterborne pigment dispersion comprising pigment dispersed in water in the presence of a pigment dispersant. The aqueous pigment dispersion itself being in dispersion in said solution of organic solution. The combination of the Kubitza reference and the Fenn

reference does not disclose or teach a paint pack having a **waterborne pigment dispersion comprising pigment dispersed in water in the presence of a pigment dispersant whereby the aqueous pigment dispersion is dispersed in said solution of organic solvent (which contains the polymer).**

For the reasons stated above, the rejection claims 11-12, 16-18, 20-21, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Kubitza in view of Fenn are improper and should be withdrawn.

### **III. Claim Objections**

In the Office Action, claims 7, 19, and 22-23 are objected to as being dependent upon a rejected base claim. The Examiner stated that claims 7, 19, and 22-23 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

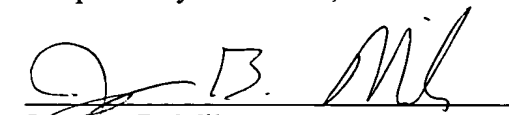
In light of the amendments and remarks above, the objection of claims 7, 19, and 22-23 is moot. The amended independent claims and corresponding dependent claims should be allowed as presently drafted.

### **CONCLUSION**

In light of the amendments and remarks above, the present application should be in condition for allowance. The rejection of claims 1-6, 8-10, and 13-15 under 35 U.S.C. §102(b) over Kubitza and the rejection of claims 11-12, 16-18, 20-21, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Kubitza in view of Fenn are improper and should be withdrawn. If you have any questions, please give me a call at the telephone number below.

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Respectfully submitted,

  
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**APPENDIX**  
**Marked Up Version of Amended Claims**

1. (twice amended) A **non crosslinker containing** pigmented solventborne paint pack which can be made into a waterborne coating composition comprising:

- i) a solution in an organic solvent of polymer having functional groups and hydrophilic groups; and
- ii) a waterborne pigment dispersion comprising pigment dispersed in water in the presence of a pigment dispersant, the aqueous pigment dispersion itself being in dispersion in said solution of organic solvent.

20. (twice amended) A process for producing a **non crosslinker containing** solventborne paint pack which can be made into a pigmented waterborne coating composition, comprising a polymer having hydrophilic groups and functional groups **and a waterborne pigment dispersion**, ~~and a crosslinker for the polymer~~, comprising the steps of:

- i) forming a solution of the polymer in an organic solvent; and
- ii) dispersing a waterborne pigment dispersion **in the presence of a pigment dispersant** in the polymer solution.